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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,032	10/03/2000	Mark B. Lester	1671-0099	5677

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EXAMINER

LANDREM, KAMRIN R

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 09/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/678,032	LESTER ET AL.
	Examiner	Art Unit
	Kamrin R. Landrem	3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on \_\_\_\_\_.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-30 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-30 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 3.

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

The disclosure is objected to because of the following informalities:

A: It is unclear what encompasses “a great circle”.

B: It is unclear why the cup surface is defined as imaginary hemisphere when a definitive radius could be defined and additionally there is no point of reference for distance “D”. It is recommended that the cup be defined as a hemisphere with radius 1, and distance “D” defined with second radius 2. In order to manufacture cup there needs to be a defined shape.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4-6, 8,11-13, 15, 17-19, 21, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, it is unclear what defines imaginary hemisphere.

Claim 4, there is a lack of consistency of claim because claim defines a radius versus claim 1 which is a distance, not a radius.

Claim 5, see claim 4

Claim 6 recites the limitation "said head portion" in Claim 1. There is insufficient antecedent basis for this limitation in the claim because in Claim 1 "the head portion" is not in the body of the claim.

Claim 8, see claim 1

Claim 11, see claim 4

Claim 12, see claim 5

Claim 13, see claim 6

Claim 15, see claim 1

Claim 17, see claim 4

Claim 18, see claim 5

Claim 19, see claim 6

Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 26, see claim 21. This claim is solely to a cup system. It is unclear if the cup is defined prior to insertion or after.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-13, 15-19, and 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pratt et. al. (USPN 5,888,205).

Pratt et. al. discloses the use of a hemispherical shaped reaming tool to prepare the acetabulum for a low-profile acetabular cup design that is less than a hemisphere. Pratt et. al. also discloses the technique of using a reamer that is approximately 2 mm smaller than the desired acetabular cup to insure a secure press-fit. Although Pratt does not inherently state the specifics of the claims, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method and assembly of Pratt et. al. to meet desirable design specifications.

Claims 1-6, 8-13, 15-19, and 21-30, with regards to reamer and method of press-fitting cup, see Pratt et. al. col. 1, lines 60-67 and col. 2, lines 1-13.

Claims 7, 14, and 20, with regards to seating acetabular cup substantially flush with distal surface of said acetabulum, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the commonly practiced surgical technique to prevent impingement and increase range of motion.

As worded, claims cannot be distinguished from prior art unless applicant discloses support for the design specifics (i.e. imaginary hemisphere distance D equal to 2 mm).

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The surgical techniques for DURALOC and Pinnacle acetabular cups teach the

method of reaming and placing acetabular cup substantially flush with distal surface of the acetabulum (see Figure 18 of Pinnacle procedure).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamrin R. Landrem whose telephone number is 703-305-8061. The examiner can normally be reached on 8:00-5:00, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-3905 for regular communications and 703-308-3905 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Kamrin Landrem  
Examiner  
AU 3738

KRL  
September 6, 2002

  
David J. Isabella  
Primary Examiner